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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,417	04/13/2007	Hiroshi Yahata	50478-3200	2430
52044 7590 10/05/2009 SNELL & WILMER L.L.P. (Panasonic) 600 ANTON BOULEVARD SUITE 1400 COSTA MESA, CA 92626			EXAMINER SHIBRU, HELEN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 10/05/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,417	<b>Applicant(s)</b> YAHATA, HIROSHI	
	<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4,7 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,9,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/2006,07/19/2006</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 7, 10, and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). However upon further consideration, claims 4 and 11-12 are withdrawn as being drawn to the non elected species, figure 44A. See paragraph 00275 and figure 44A.

The restriction is now made Final.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 recites the limitation "the supplemental" in line 10. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims recited a program and the program performs a set of instructions *per se* and program is a signal. Therefore program is not patent-eligible subject matter and therefore is non-statutory.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-6, 8-9 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoi (US PG PUB 2001/0012440).

Claims 6 and 8-9 will be discussed first.

Regarding claim 6, Itoi teaches a playback device for executing playback of video composed of a plurality of frame images, comprising: a read unit operable to read a video stream from a recording medium (see paragraph 0044); a frame memory (see TV 5 in figure 1); a video decoder operable to decode the video stream so as to sequentially obtain and write the frame images on the frame memory (see paragraphs 0044-0045); an output unit operable to generate a video signal from the frame images sequentially written on the frame memory and output the video signal (see paragraph 0048); an output control unit operable, in accordance with a user operation, to cause the output unit to output the video signal with addition of the supplemental information (see paragraph 0041); and an assigning unit operable to assign, to the video signal added with the supplemental information, copy control information defining a less strict

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restriction as compared with copy control information to be assigned to the video signal output without addition of the supplemental information (see paragraph 0062 and claim 7 where the prior art teaches contents with out commercial message are controlled and contents with commercial having control code representing copy-free condition).

Regarding claim 8, Itio teaches the recording medium is a portable recording medium (see figure 1 and paragraphs 0034-0037), the playback device further comprises: a built-in recording medium storing a supplemental information stream (see paragraph 0034 and 0061 and figure 2), the read unit is further operable to read the supplemental information stream from the built-in recording medium (see claims 1-2), the playback device further comprises: a supplemental information decoder operable to decode the supplemental information stream (see claim 7), and the supplemental information is an image obtained by decoding the supplemental information stream (see paragraph 0056).

Regarding claim 9, Itio discloses the built-in recording medium stores multi-path information binding the supplemental information stream to a section of the video stream on the portable medium (see paragraph 0067), and the output of the video signal with addition of the supplemental information by the output control unit is performed when a current playback point reaches the section (see paragraphs 0068-0069).

Regarding claims 14-15, the limitation of claims 14-15 can be found in claim 6 above. Therefore claims 14-15 are analyzed and rejected for the same reason.

Regarding claim 1, Itio teaches a recording medium comprising: a video stream (see paragraph 0067 and figure 3); and copy control information (see claim 7 and abstract), wherein the video stream contains video composed of a plurality of frame images (see figure 3), and the

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copy control information defines different restrictions on recording of a video signal that is converted from the frame images, the restrictions differing depending on whether the video signal is output with or without addition of supplemental information (see rejection of claim 6 above).

Regarding claim 2, Itio discloses a graphics stream, wherein the supplemental information is graphics obtained by decoding the graphics stream (see paragraph 0056).

Regarding claim 3, Itio teaches the graphics stream includes: graphics data composed of a sequence of pixel codes each representing a character string or a figure (see abstract, paragraphs 0031 and 0038); and pallet data indicating pixel codes each associated with a pair composed of a pixel value and a transparency value (see paragraphs 0041 and 0043).

Regarding claim 5, Itio teaches a supplemental information stream (see abstract); and multi-path information binding the supplemental information stream to a section of the video stream (see paragraph 0067), wherein the supplemental information is obtained by decoding the supplemental information stream (see paragraph 0056).

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
September 24, 2009

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621